

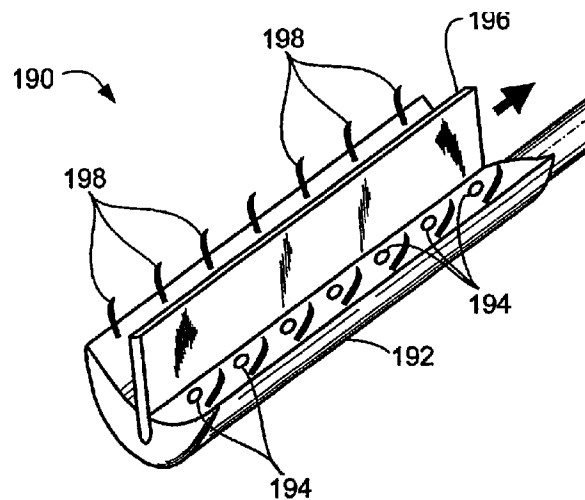
## REMARKS

This Amendment is responsive to the Office Action dated December 16, 2008. In the application claims 29 - 34 are pending and each claim stands rejected under the combination of Deem, U.S. Patent No. 6,558,400 with Adams et al., U.S. Patent Publication No. 2003/0132267 ("Adams"). Reconsideration is respectfully requested.

### Claim 29

Claim 29 is directed to a gastroplasty device that includes first and second tissue acquisition members, each acquisition member including a tissue receiving cavity, and a stapler. The Office Action states: "Deem discloses the claimed device except for the first tissue acquisition member being pivotable about the longitudinal axis." The Office Action then states that it would have been obvious "to provide a pivotable first tissue acquisition member, as taught by Adams et al., to Deem in order to accommodate variable-sized tissue selections and since it was known in the art that pivotable tissue acquisition members facilitate grasping and apposition of tissue to ensure engagement of tissue." [Office Action, p. 3]. Applicant respectfully traverses that Deem and Adams suggest the claimed invention.

Deem discloses various devices in FIGs. 9A - 11B where a single, rigid structure serves as both a tissue acquisition device and a stapling mechanism. The device is purported to create the multi-lumen condition shown in FIG. 8A. [Column 10, lines 27 - 67] FIG. 10 of Deem, shown right, shows that staples are housed in the structure so as to protrude out of both sides of the stapling unit 192 (see also reference no. 176 of FIG. 9A). Because the object



of the Deem device is to create the condition of FIG. 8A, there is nothing that would appear to be gained by introducing a pivoting operation. Because the staple housing 192 compactly contains the staples so that each staple lies on both sides of the tissue acquisition member, the profile is relatively small making it easier to pass through the esophagus. If the tissue acquisition members were pivotable, as suggested by the Office Action, the staple housing could no longer hold staples 198 as shown, necessitating that the device be wider, taller, and more complex for no apparent benefit.

The Office Action contends, however, that providing a pivotable first tissue acquisition member as taught by Adams would allow the Deem device to "accommodate variably-sized tissue." Applicant initially points out that this is not even a claim limitation. Further, given the object of Deem as shown in FIG. 8A, Applicant is unclear to what the Office Action is referring. Deem teaches that creating the two lumen condition requires that two opposing surfaces be brought together and stapled. The length of the staple line is accounted for by moving the stapler longitudinally. [Deem, Col. 11, lines 51 - 56] The Office Action points to nothing in either cited reference that discusses "variably-sized" stomach wall tissue or problems that the Deem device might encounter with "variably-sized" stomach wall tissue. Objectively, Applicant finds no benefit to the Office Action's proposed combination except that it purports to invalidate Applicant's claimed invention. This is not the proper basis for an obviousness rejection.

Moreover, the Adams reference does not teach "first and second tissue acquisition members where the first tissue acquisition member is pivotable about the longitudinal axis of the stapler in relation to a second tissue acquisition member" as contended by the Office Action. Adams teaches a staple and anvil that pivot about a hinge pin 60, but elements 10 and 17 are not "tissue acquisition members." Tissue must be brought between the stapler and anvil by other means, as there is nothing on elements 10 and 17 that is capable of **acquiring** tissue as that term is used in the present patent. Rather,

Adams teaches that grasping devices **108** are used to acquire tissue [¶0068]. Because Adams does not teach pivoting tissue acquisition members, the rejection of Claim 29 based on this premise is incorrect and properly withdrawn. Since this is the only rejection of Claim 29, Claim 29 is respectfully submitted to be in condition for allowance.

Moreover, the use of the staples in both the left and right halves of the Deem apparatus shown above strongly teach away from having pivotable halves since it would serve no purpose here. Conversely, the grasping arm of the Adams apparatus uses a pinching motion to cause the stomach wall to fold. Unlike Deem, there is no vacuum used in the Adams device. Accordingly, the two devices teach **alternate** but **separate** methodologies for creating a fold of tissue that do not suggest a combination of the two technologies. Because the Deem device cannot pivot as constituted, and re-engineering the Deem device to allow it to pivot would necessitate an entirely different stapling system, the Office Action's proposed combination finds no support in the record. Because the rejection unduly relies on the Applicant's teachings to formulate the proposed combination of Deem and Adams, Applicant respectfully submits that a *prima facie* case of obviousness has not been established and that the claims must be reconsidered in light of what the prior art references **actually suggest** to one of ordinary skill in the art without the benefit of the Applicant's present teaching.

New claim 35 recites features of the invention that are not found in the cited art, and are submitted to be patentable over the art of record. Newly added dependent claim 36 depends from new claim 35 and is asserted to be in allowable condition as well. Accordingly, Applicant respectfully submits that the application is now in condition for allowance.

If the Examiner believes that a telephone conference will further the prosecution of this case, the Examiner is kindly invited to contact the undersigned at the number below. The Commissioner is authorized to charge any deficiencies or fees in connection with this preliminary amendment to Deposit Account No. 06-2425.

Respectfully submitted,

FULWIDER PATTON LLP

By: /michael j. moffatt/  
Michael J. Moffatt  
Registration No. 39,304

MJM:spc  
Howard Hughes Center  
6060 Center Drive, Tenth Floor  
Los Angeles, CA 90045  
Telephone: (310) 824-5555  
Facsimile: (310) 824-9696  
Customer No. 24201  
320490.1